

### **REMARKS**

In response to the Office Action dated 27 December 2004, the applicants request reconsideration of the above-identified application in view of the following remarks. Claims 1-29 are pending in the application, and are rejected. None of the claims are amended herein.

#### **Rejection of Claims Under §102**

Claims 1, 2, 14-16, and 21-22 were rejected under 35 USC § 102(e) as being anticipated by Waites et al. (U.S. 6,788,769, Waites). The applicants respectfully traverse.

Waites issued on September 7, 2004, which is after the 24 August 2001 filing date of the present application. The applicant does not admit that Waites is prior art, and reserves the right to swear behind Waites at a later date.

Independent claim 1 recites a method comprising, among other features, converting input speech to text and transmitting an instant message comprising the text.

Independent claim 14 recites an instant-messaging system, comprising, among other features, a controller to send an instant message to an instant-messaging server.

Independent claim 21 recites a signal-bearing medium comprising instructions, wherein the instructions when read and executed by a processor comprise, among other features, transmitting an instant message to an instant-messaging server.

Waites relates to an internet directory system and method using telephone number based addressing.<sup>1</sup> The "directory system utilizes a user's telephone number for the respective user's e-mail address and web home page."<sup>2</sup> However, Waites does not show or describe transmitting an instant message or sending an instant message as claimed. In fact, the examples of communication in Waites are limited to sending a user e-mail, accessing a user's web site,<sup>3</sup> a non-computer user calling from a telephone,<sup>4</sup> and sending a fax.<sup>5</sup> Waites also indicates that the

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<sup>1</sup> Waites, Title.

<sup>2</sup> Waites, column 6, lines 22-25.

<sup>3</sup> Waites, column 7, lines 57-65.

<sup>4</sup> Waites, column 8, lines 37-59.

<sup>5</sup> Waites, column 13, lines 17-31.

directory system provides unified messaging enabling users to transmit communications using e-mail, telephone, paging, or fax.<sup>6</sup> Instant messaging is not included in this list.

Instant messaging is substantially different from these other forms of communication.

The Background of the instant application states:

“Whereas email is a store-and-forward system based on short-lived connections, recipients listening for instant messages remain connected to their server on a long-lived connection. This long-lived connection allows instant messages to be delivered in close to real time.”<sup>7</sup>

Other distinguishing features of instant messaging are also described in the Background. The applicants have submitted several references in the Information Disclosure Statement filed 13 March 2002 that distinguish instant messaging from other forms of communication.

Waites refers to the directory system as offering the capability to locate the person’s instant message address using a person’s telephone number.<sup>8</sup> Waites also says that the directory system “provides addressing for unified messaging” including instant messaging.<sup>9</sup> Waites does not show or describe transmitting an instant message or sending an instant message as claimed in independent claims 1, 14, and 21. The Office Action cited the “Field of the Invention” in Waites that mentions instant messaging along with other forms of communication.<sup>10</sup> The “Field of the Invention” does not describe an instant messaging system, but is a broad reference to the field of electronic communications.

The Office Action also states that several features are “inherent” in Waites. For example:

“Waites’ originating device inherently comprises a controller...The terminals inherently comprise software on a signal bearing medium.”<sup>11</sup>

The MPEP states that missing matter must be “necessarily present” in the reference to support a rejection based on inherency:

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<sup>6</sup> Waites, column 11, lines 24-43.

<sup>7</sup> Description, page 1, lines 25-30.

<sup>8</sup> Waites, column 8, lines 29-37.

<sup>9</sup> Waites, column 2, lines 55-62.

<sup>10</sup> Office Action, page 3.

<sup>11</sup> Office Action, page 3.

“To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.”<sup>12</sup>

The MPEP further states that the examiner must provide a basis to support a determination that the allegedly inherent characteristic necessarily flows from the teaching of the art:

“In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.”<sup>13</sup>

The Office Action has not provided a sufficient basis in fact and/or technical reasoning to reasonably support its contention that the “originating device inherently comprises a controller” or that the “terminals inherently comprise software.”

The applicants respectfully submit that Waites does not show all of the features recited in independent claims 1, 14, and 21, and that claims 1, 14, and 21 are in condition for allowance. Claims 2, 15-16, and 22 are variously dependent on claims 1, 14, and 21, and recite further features with respect to claims 1, 14, and 21. For reasons analogous to those stated above, and the features in the claims, the applicants respectfully submit that Waites does not show all of the features recited in claims 2, 15-16, and 22, and that claims 2, 15-16, and 22 are in condition for allowance.

Claims 6-10 and 12 were rejected under 35 USC §102(e) as being anticipated by Andrews et al. (U.S. 6,522,878, Andrews). The applicants respectfully traverse.

Andrews issued on February 18, 2003, which is after the 24 August 2001 filing date of the present application. The applicant does not admit that Andrews is prior art, and reserves the right to swear behind Andrews at a later date.

Independent claim 6 recites a method comprising, among other features, receiving an instant message.

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<sup>12</sup> MPEP 2112.

<sup>13</sup> MPEP 2112. Emphasis in original.

Independent claim 10 recites a computing device comprising a text-to-speech converter to convert text in a received instant message to speech when a speech option is selected, independent of whether a sender of the instant message performed speech input.

Andrews relates to in-band audio signaling<sup>14</sup> and describes cellular telephones enabling alphanumeric pages.<sup>15</sup> An alphanumeric page is not an instant message, for reasons analogous to those stated above with respect to Waites. Andrews does not show or discuss an instant message as is recited in independent claims 6 and 10.

The applicants respectfully submit that Andrews does not show all of the features recited in independent claims 6 and 10, and that claims 6 and 10 are in condition for allowance. Claims 7-9 and 12 are variously dependent on claims 6 and 10, and recite further features with respect to claims 6 and 10. For reasons analogous to those stated above, and the features in the claims, the applicants respectfully submit that Andrews does not show all of the features recited in claims 7-9 and 12, and that claims 7-9 and 12 are in condition for allowance.

#### Rejection of Claims Under §103

Claims 3-5, 18, and 23-25 were rejected under 35 USC § 103(a) as being unpatentable over Waites in view of Andrews. The applicants respectfully traverse.

Claims 3-5, 18, and 23-25 are variously dependent on claims 1, 14, and 21, and recite further features with respect to claims 1, 14, and 21.

As discussed above, Waites does not show or describe transmitting an instant message or sending an instant message as claimed in independent claims 1, 14, and 21. Andrews does not supply the features missing in Waites as Andrews does not show or discuss an instant message. Therefore, even as combined, Waites and Andrews do not show all of the features recited in claims 3-5, 18, and 23-25. Furthermore, there is no suggestion for combining Waites with Andrews.

The Office Action states that:

“It would have been obvious...that the receiving pager of Waites’ system could comprise a text-to-speech converter for the

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<sup>14</sup> Andrews, Title.

<sup>15</sup> Andrews, column 4, lines 12-22.

advantage of providing a user with an additional interface (hearing) to communicate with.”<sup>16</sup>

The MPEP requires a suggestion and a reasonable expectation of success for a rejection under 35 USC § 103:

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.”<sup>17</sup>

The suggestion or motivation to combine references and the reasonable expectation of success must both be found in the prior art.<sup>18</sup>

As stated above, Waites and Andrews do not show all of the features recited in claims 3-5, 18, and 23-25. Also, the Office Action has not identified prior art as being the source of the above-quoted rationale for combining Waites with Andrews as is required by MPEP 2143. The Office Action has also not identified a reasonable expectation of success in the prior art as is required by MPEP 2143.

The applicants respectfully submit that a *prima facie* case of obviousness has not been established against claims 3-5, 18, and 23-25, and that claims 3-5, 18, and 23-25 are in condition for allowance.

Claims 19-20 and 26-29 were rejected under 35 USC § 103(a) as being unpatentable over Waites in view of Andrews. The applicants respectfully traverse.

Independent claim 19 recites an instant-messaging system, comprising, among other features, an instant messaging server and an origin controller to send an instant message to the instant- messaging server.

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<sup>16</sup> Office Action, page 5.

<sup>17</sup> MPEP 2143.

<sup>18</sup> MPEP 2143.

Independent claim 26 recites a pager comprising a text-to-speech converter to convert text in a received instant message to speech when a speech option is selected, independent of whether a sender of the instant message performed speech input.

Claims 20 and 27-29 are variously dependent on independent claims 19 and 26.

With reference to the remarks above, Waites does not show or describe sending an instant message or a received instant message as claimed in independent claims 19 and 26, respectively. Andrews does not supply the features missing in Waites as Andrews does not show or discuss an instant message. Therefore, even as combined, Waites and Andrews do not show all of the features recited in claims 19-20 and 26-29. Furthermore, there is no suggestion for combining Waites with Andrews.

The Office Action states that:

“It would have been obvious...that the receiving pager of Waites’ system could comprise a text-to-speech converter for the advantage of providing a user with an additional interface (hearing) to communicate with.”<sup>19</sup>

The Office Action has not identified prior art as being the source of the above-quoted rationale for combining Waites with Andrews as is required by MPEP 2143. The Office Action has also not identified a reasonable expectation of success in the prior art as is required by MPEP 2143.

The applicants respectfully submit that a *prima facie* case of obviousness has not been established against claims 19-20 and 26-29, and that claims 19-20 and 26-29 are in condition for allowance.

Claim 17 was rejected under 35 USC § 103(a) as being unpatentable over Waites in view of Ogle et al. (U.S. 6,430,604, Ogle). The applicants respectfully traverse.

Ogle issued on 6 August 2002, which is after the filing date of the present application. The applicant does not admit that Ogle is prior art, and reserves the right to swear behind Ogle at a later date.

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<sup>19</sup> Office Action, page 6.

Ogle relates to a system “for enabling messaging systems to use alternative message delivery mechanisms.”<sup>20</sup>

Claim 17 is dependent on claim 14, and recites further features with respect to claim 14. With reference to the remarks made regarding claim 14 above, the Office Action has not shown that Ogle supplies the features missing in Waites. The Office Action states that:

“It would have been obvious...that an IM server could drop a message if the receiving device were not connected for the reason that the server not get overloaded with undelivered messages.”<sup>21</sup>

The Office Action has not identified prior art as being the source of the above-quoted rationale for combining Waites with Ogle as is required by MPEP 2143. The Office Action has also not identified a reasonable expectation of success in the prior art as is required by MPEP 2143.

The applicants respectfully submit that a *prima facie* case of obviousness has not been established against claim 17, and that claim 17 is in condition for allowance.

Claims 11 and 13 were rejected under 35 USC § 103(a) as being unpatentable over Andrews in view of Waites. The applicants respectfully traverse.

Claims 11 and 13 are dependent on independent claim 10, and recite further features with respect to claim 10. As discussed above with respect to claim 10, Andrews does not show or discuss an instant message as is recited in independent claim 10. With reference to the remarks above, Waites does not show or describe transmitting an instant message or sending an instant message. The Office Action has not shown that Waites supplies the features missing in Andrews. Furthermore, there is no suggestion for combining Waites with Andrews.

The Office Action states that:

“It would have been obvious...that the sending device could comprise a speech-to-text converter for the purpose of providing an additional interface for the sender.”<sup>22</sup>

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<sup>20</sup> Ogle, Abstract.

<sup>21</sup> Office Action, page 7.

<sup>22</sup> Office Action, page 7.

The Office Action has not identified prior art as being the source of the above-quoted rationale for combining Waites with Andrews as is required by MPEP 2143. The Office Action has also not identified a reasonable expectation of success in the prior art as is required by MPEP 2143.

The applicants respectfully submit that a *prima facie* case of obviousness has not been established against claims 11 and 13, and that claims 11 and 13 are in condition for allowance.



**CONCLUSION**

The applicants respectfully submit that all of the pending claims are in condition for allowance, and such action is earnestly solicited. The Examiner is invited to telephone the below-signed attorney at 612-373-6973 to discuss any questions which may remain with respect to the present application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

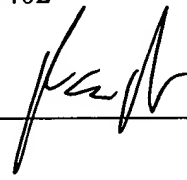
Respectfully submitted,

NIKHIL M. DESHPANDE ET AL.

By their Representatives,

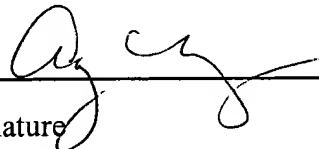
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Date 28 March 2005

By   
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